

REMARKS

This is in full and timely response the Office Action mailed on October 6, 2009.

Claims 1-338 are currently pending within the above-identified application.

No new matter has been added.

Reexamination in light of the following remarks is respectfully requested.

Entry of amendment

This amendment *prima facie* places the case in condition for allowance. Alternatively, it places this case in better condition for appeal.

Accordingly, entry of this amendment is respectfully requested.

Allowable subject matter

Appreciation is expressed for the indication on page 3 that claims 1-306 contain allowable subject matter.

Oath or Declaration

Please hold the requirement for a new Oath/Declaration in abeyance until all art rejections are overcome.

At that stage, an appropriate response may be addressed if still deemed necessary by the Examiner.

Claim rejections

1. **Page 2 of the Office Action includes a rejection of claims 307-335 under 35 U.S.C. §101.**

As a response to this rejection, *In re Bernhart and Fetter*, 163 USPQ 611, 616 (C.C.P.A. 1969) explains the following:

If a machine is programmed in a certain new and unobvious way, it is physically different from the machine without that program; its memory elements are differently arranged. The fact that these physical changes are invisible to the eye should not tempt us to conclude that the machine has not been changed. If a new machine has not been invented, certainly a “new and useful improvement” of the unprogrammed machine has been, and **Congress has said in 35 U.S.C. 101 that such improvements are statutory subject matter for a patent.**

While not conceding the propriety of the rejections and in order to advance the prosecution of the present application, the rejected claims have been amended.

2. **Page 3 of the Office Action includes a rejection of claims 336-338 under 35 U.S.C. §112.**

The Office Action contends that claims 336-338 is directed to an apparatus but recites a method in the claim body, resulting in the indefiniteness of claims 336-338 as a result (Final Office Action at page 3).

Here, the rejection of claims 336-338 within the Final Office Action appears to be relying upon M.P.E.P. § 2173.05(p)(II), which provides the following:

A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. **>IPXL Holdings v. Amazon.com, Inc.*, 430 F.2d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005); *< Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990) **>(<*

claim directed to an automatic transmission workstand and the method * of using it * held ** ambiguous and properly rejected under 35 U.S.C. 112, second paragraph>)<.

Such claims *>may< also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

However, more recent precedent from the Court of Appeals for the Federal Circuit has provided some clarity to the principles of *IPXL Holdings* and *Ex parte Lyell*.

Specifically, functional language may also be employed to limit the claims without using the means-plus-function format. *Microprocessor Enhancement Corp. v. Texas Instruments Inc.*, 86 USPQ2d 1225, 1230 (Fed. Cir. 2008).

Thus, the metes and bounds of the claims could be readily obtained by the skilled artisan.

Withdrawal of the rejections and allowance of the claims is respectfully requested.

Official Notice

There is no concession as to the veracity of Official Notice, if taken in any Office Action.

An affidavit or document should be provided in support of any Official Notice taken. 37 C.F.R. 1.104(d)(2), M.P.E.P. §2144.03. See also, *Ex parte Natale*, 11 USPQ2d 1222, 1227-1228 (Bd. Pat. App. & Int. 1989)(failure to provide any objective evidence to support the challenged use of Official Notice constitutes clear and reversible error).

Extensions of time

Please treat any concurrent or future reply, requiring a petition for an extension of time under 37 C.F.R. §1.136, as incorporating a petition for extension of time for the appropriate length of time.

The Commissioner is hereby authorized to charge all required fees, fees under 37 C.F.R. §1.17, or all required extension of time fees.

Fees-general authorization

The Commissioner is hereby authorized to charge any deficiency in fees filed, asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm).

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Conclusion

This response is believed to be a complete response to the Office Action.

Applicants reserve the right to set forth further arguments supporting the patentability of their claims, including the separate patentability of the dependent claims not explicitly addressed herein, in future papers.

For the foregoing reasons, all the claims now pending in the present application are allowable, and the present application is in condition for allowance.

Accordingly, favorable reexamination and reconsideration of the application in light of the remarks is courteously solicited.

If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone Brian K. Dutton, Reg. No. 47,255, at 202-955-8753.

Dated: December 16, 2009

Respectfully submitted,

By 

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